REMARKS

This Amendment modifies the Request for Continued Examination (RCE) filed herewith.

Applicant appreciates the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claims 1, 15, 20, and 30-32 have been amended, and new claims 34-38 have been added. Support for any claim amendments and new claims is found in the specification, claims, and drawings as originally filed, and no new matter has been added. Accordingly, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

Rejections.

Rejection Under 35USC §102

Claims 1-3, 15-16, 20-21, and 30-31 have been rejected under 35 USC §102(e), as being anticipated by U.S. patent 7,065,567 to Squires ("Squires"). Applicants respectfully traverse the rejection and request reconsideration based on features in the claims which are not disclosed in the cited reference.

As to a rejection under §102, "[a]nticipation is established only when a single prior art reference discloses expressly or under the principles of inherence, each and every element of the claimed invention." *RCA Corp. v. Applied Digital Data Systems, Inc., (1984, CAFC) 221 U.S.P.Q. 385.* The standard for lack of novelty, that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential

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elements of the particular claims. *Schroeder v. Owens-Corning Fiberglass Corp., 514 F.2d 901, 185 U.S.P.Q. 723 (9th Cir. 1975); and Cool-Fin Elecs. Corp. v. International Elec. Research Corp., 491 F.2d 660, 180 U.S.P.Q. 481 (9th Cir. 1974)*. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)*. The elements must be arranged as required by the claim. *In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)*.

The rejection of independent claim 20, and its dependent claim 21, is respectfully traversed at least because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims. In this regard, claim 20 recites:

"20. (Currently amended) A workflow assignment method comprising:
receiving a user request at a server, the request having one or more user-desired product properties;
providing in the server a prestored stylesheet having predefined rules for processing the user request;
loading the predefined rules and the user request into a processing circuitry of the server, the circuitry configured to process the user request; and
without communicating with one or more workflow processing devices, executing the predefined rules on the server to create a transformed user request, the transformed user request comprising additional information not present in the user request to automatically organize workflow among the one or more workflow processing devices in accordance with the one or more user-desired product properties to produce a user-desired product." (emphasis added)

Claim 20 recites receiving a user request at a server and, without communicating with workflow processing devices, executing predefined rules on the server to create a transformed user request that comprises additional information not present in the user request to automatically organize workflow among the one or more workflow processing devices. However, any transformed user request created according to the Squires reference does not comprise any additional information beyond that which is already present in the original user request.

With regard to the transformed user request comprising additional information, the Office

cites the operation of job decomposition module 64 described at col. 5, ln. 42-54, and Fig. 8 of

the Squires reference (Final Office Action, p.5):

"The job decomposition module 64 uses workflow information created by the workflow mapping module 46 to decide how to split the document processing job 62. Once the document processing job 62 has been split, the sub-jobs 66, 68, 70 are sent to a number of cells 72, 74, 76 for further processing. The job decomposition module 64 provides a flexible way to distribute sub-jobs 66, 68, 70 to cells 72, 74, 76 in the network. For example, when cell 72 receives sub-job 66, the cell 72 determines how to process sub-job 72 among the printing and/or finishing devices 77, 78, 79. The job decomposition module 64 decides which of the cells 72, 74, 76 will receive the sub-jobs 66, 68, 70 to efficiently process document processing job 62." (col. 5, ln. 42-54; emphasis added)

Thus module 64 decomposes, or splits, a larger document processing job into a plurality

of smaller sub-jobs. The Squires reference further teaches in this regard:

"The document processing job 62 is composed of a multitude of printing requests. Dependent on the size of the document processing job 62 and the overall capacity of the cell arrangements in the network, the job decomposition module 64 determines how to process the document processing job 62. In the case shown in FIG. 8, the job decomposition module 64 splits the document processing job 62 into autonomous sub-jobs 66, 68, 70." (col. 5, ln. 34-41; emphasis added)

The decomposition of the document processing job 62 into sub-jobs can be further

understood with reference to Fig. 7 of the Squires reference:

"For example, the workflow 46 demonstrates a document processing job to print fifty blue envelopes with red and black lettering and to print 1000 pages of a certain document with black lettering of two kinds of letterhead A & B. The workflow mapping module splits the fifty blue-type envelopes with red and black lettering and the 1000-page document with black lettering of two kinds of letterhead A & B into sub-jobs 48, 50. Thus, creating two sub-jobs 48, 50 that are mutually independent from each other." (col. 5, ln. 2-10; emphasis added)

To whatever extent, if any, that a sub-job can arguendo be considered to be a

"transformed user request" of the original user request (i.e. the document processing job), the

sub-job does not contain any additional information that is not present in the original document

processing job.

The Advisory Action states that "features upon which the applicant relies ... are not

recited in the rejected claims" (Advisory Action, p.2). Applicant notes that claim 20, prior to

amendment herein, recited "the transformed user request comprising additional information". Such additional information is not disclosed by the Squires reference. However, claim 20 been further amended to more particularly point out the distinction by reciting that the additional information is "not present in the user request".

The novel features of the present invention are not anticipated by the Squires reference in that the essential element of a transformed user request that comprises additional information not present in the user request to automatically organize workflow among the one or more workflow processing devices, arranged as required by the claims and recited in as complete detail as in the claim, is absent from the reference because the reference teaches merely decomposing or splitting up the original document processing job. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Independent claims 30 and 31 were "rejected for the same reasons as claim 20" (Final Office Action, p.5). These claims have been amended herewith to each recite "the transformed user request comprising additional information not present in the user request for automatically organizing workflow", similar to claim 20. For similar reasons as explained heretofore with regard to claim 20, the novel features of the present invention are not anticipated by the Squires reference in that at least one essential element, arranged as required by the claims and in as complete detail as in the claims, is absent from the reference. Therefore, the rejection of independent claims 30 and 31 is improper at least for this reason and should be withdrawn.

Independent claims 1 and 15 have been amended herewith to each recite "the transformed (user) request comprising additional information not present in the user request for automatically organizing workflow", similar to claim 20. For similar reasons as explained heretofore with regard to claim 20, the novel features of the present invention are not anticipated by the Squires reference in that at least one essential element, arranged as required by the claims and in as complete detail as in the claims, is absent from the reference. Therefore, the rejection of

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independent claims 1 and 15, and their dependent claims 2-3 and 16, is improper at least for this reason and should be withdrawn.

Rejection Under 35USC §103

As to a rejection under §103(a), the U.S. Patent and Trademark Office ("USPTO") has the burden under §103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988)*. The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

More recently, the Supreme Court, quoting *In Re Kahn, 441 F.3d, 977, 988 (CA Fed. 2006)*, has clarified that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" *Teleflex Inc. v. KSR Int'l Co., 82 USPQ2d 1385, 1396 (S.Ct. 2007)*.

Claims 4-5, 17, 22, and 24 have been rejected under 35 USC §103 (a), as being unpatentable over U.S. patent 7,065,567 to Squires ("Squires") in view of U.S. published patent application 2002/0184240 by Volkoff et al. ("Volkoff"). Applicant respectfully traverses the

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rejection and requests reconsideration at least based on the dependence of these claims on one of independent claims 1, 15, and 20, whose reasons for allowability over the Squires reference have been discussed heretofore and against which the Volkoff reference has not been cited. In addition, the reason articulated by the Office for combining the prior art elements in the manner claimed lacks a rational underpinning that would have prompted a person of ordinary skill in the relevant field to make the modification. Accordingly, the Office impermissibly uses the Applicant's disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claims 6-9, 18-19, 23, 25-26, and 32-33 have been rejected under 35 USC §103 (a), as being unpatentable over U.S. patent 7,065,567 to Squires ("Squires") in view of U.S. patent 6,507,857 to Yalcinalp ("Yalcinalp"). Applicant respectfully traverses the rejection and requests reconsideration at least based on the dependence of these claims on one of independent claims 1, 15, and 20, whose reasons for allowability over the Squires reference have been discussed heretofore and against which the Yalcinalp reference has not been cited. In addition, the reason articulated by the Office for combining the prior art elements in the manner claimed lacks a rational underpinning that would have prompted a person of ordinary skill in the relevant field to make the modification. Accordingly, the Office impermissibly uses the Applicant's disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

In addition, dependent claim 32 is patentably distinguishable over the cited references for further reasons. Claim 32 recites:

"32. (Currently amended) The device of claim 9, wherein each of a plurality of stylesheets corresponds to a different subset of the product properties, and at least two of the plurality of stylesheets comprise instructions related to at least one same one of the workflow processing devices." (emphasis added)

The Office cites Figs. 4 and 7 of the Squires reference, which illustrate different sub-jobs

48,50 resulting from the decomposition of the document processing job by the job decomposition module 14 (Advisory Action, p.2). As taught by the Squires reference:

> "the job decomposition module 14 splits a document processing job into sub-jobs to be sent to various autonomous cells for processing. The cells in the network are autonomous and can produce their respective product entirely by themselves. Thus, in the example shown in FIG. 4, a document processing job is split into sub-jobs 48 and 50 that are sent to cells 32 and 40, respectively. The product cell controllers 34 and 42 send the sub-jobs 48 and 50 to devices 36, 37, 38 and 44, 45, 46 in the respective cells 32 and 40 for processing." (col. 4, ln. 27-36)

The Office further states that "the subjob 48 transformed job request generated by sytlesheet for cell 32 (element 48) has a separate workflow ... than the workflow for subjob 50 transformed request generated by stylesheet for cell 40" (Advisory Action, p.2). Thus, each autonomous cell contains, uses, or relates to <u>different</u> ones of the workflow processing devices. This is the <u>opposite</u> of the limitation of claim 32 which recites that at least <u>two</u> of the different stylesheets comprise instructions related to at least one <u>same</u> one of the workflow processing devices. The Yalcinalp reference does not discuss workflow processing devices at all.

For these reasons, the Squires and the Yalcinalp reference, alone or in combination, do not teach or suggest the limitation that at least two of the plurality of stylesheets comprise instructions related to at least one same one of the workflow processing devices, as recited in claim 32. Any such interpretation would impermissibly rely on hindsight and use the Applicant's disclosure as a blueprint for the rejection. Therefore, the rejection of claim 32 is improper for at least this additional reason.

Conclusion

Attorney for Applicant(s) has reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for

immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.
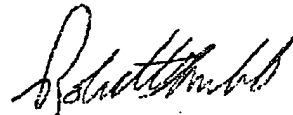
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Respectfully submitted,

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